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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,057	01/04/2000	ROBERT KLAUS	99.539	8658

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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/477,057

Applicant(s)

KLAUS, ROBERT

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/14/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. In the amendment filed 1/14/03 in paper number 11, the following has occurred: Claims 21 has been added. Now claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-10, 12-15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,093 to Walker et al. in view of Official Notice, for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

(A) Claims 1-3, 5-10, 12-15 and 17-20 have not been amended, and are rejected for the same reasons given in the previous Office Action (paper number 6), and incorporated herein. Further reasons appear hereinbelow.

(B) As per claim 21, Walker et al. teaches a method for a risk carrier to assume monetary risks from a plurality of risk cedents, comprising the steps of:

(a) the claimed posting on a computer network, a plurality of proposals to assume selected risks of respective risk cedents such that proposals are viewable through said computer network is met by the insurance company server (100, Fig. 1) that transmits policy information relating to a policy or policies to a central server (120, Fig. 1) which makes the policy information available for viewing on a website (130, Fig. 1) to user via the Internet (100, Fig. 1)

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(reads on “computer network”) through conventional interface (140, Fig. 1). A user (“risk carrier” or “investor”) browses the various policies and picks one or more he is interested in and using conventional interface selects a policy by way of an investment order (103, Fig. 1) (see: column 4, lines 45-60 and Fig. 3c);

(b) the claimed initializing on said computer network an available risk assumption capacity of said risk carrier associated with said proposals is met by central server (120, Fig. 1) which makes the policy information available for viewing on a website (130, Fig. 1) to user (risk carrier) via the Internet (100, Fig. 1) (reads on “computer network”) transmitting to the insurance company server policy information used to calculate the amount of premium to be paid to each investor (cedent) (see: column 5, lines 36-52 and Fig. 3c);

(c) the claimed enabling electronic submission by any one of said cedents of one of said proposals associated therewith as an offer for acceptance by said risk carrier is met by a users (“risk carrier” or “investor”) browsing various policies and picking one or more of interested by way of an investment order (103, Fig. 1) (see: column 4, lines 45-60 and Fig. 3c). In addition, the user (risk carrier) enters a credit card number, expiration date and personal information including an e-mail address for transmission of the investment order via the Internet (see: column 5, lines 3-8, 36-53);

(d) the claimed electronically acceptance, by said risk carrier, said offer submitted by one of said risk cedents is met by a users (“risk carrier” or “investor”) browsing various policies and picking one or more of interested using conventional interface to select a policy by way of an investment order (103, Fig. 1) (see: column 4, lines 45-60 and Fig. 3c), In addition, digital

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signatures are used to insure the acceptance of a risk associated with a given policy (see: column 10, lines 41-54); and

(e) the claimed electronically recalculating said available risk assumption capacity upon accepting said offer is met by an insurance syndication central server (120, Fig. 1) that transmits to the insurance company server policy information used to calculate the amount of premium to be paid to by each investor ("risk carrier" or "reinsurer") (see: column 5, lines 36-52 and Fig. 3c). In addition, the syndication central server transmits updated syndication and transaction information (108, Fig. 1) to the insurance company server (see: column 5, lines 44-47). This suggests that once the investor ("risk carrier" or "reinsurer") makes payment, the amount of available risk assumption capacity is decreased (recalculated) and the policy information is updated.

Walker et al. fails to explicitly teach the claimed step of (f) electronically withdrawing from availability any or said proposals whose acceptance would reduce said available risk assumptions capacity, as recalculated, below a selected amount, such that electronic submission of any of said proposals which have been withdrawn from availability is prevented.

However, Walker et al. teaches in one particular preferred embodiment, investors (reads on "risk carrier" or "reinsurer") themselves arriving at a rate for a policy, by offering bids against a given portion of risk (see: column 14, lines 19-25). Moreover, Walker et al. teaches a syndication central server that transmits updated syndication and transaction information (108, Fig. 1) to the insurance company server suggesting that once a investor ("risk carrier" or "reinsurer") makes payment, the amount of available risk assumptions capacity is decreased (recalculated) and the policy information is updated (see: column 5, lines 44-47). In addition, it

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old and well known in the insurance industry to restrict user access to certain information once a user has selected a specific type of insurance or reached certain monetary limit. For example, if a user on an insurance web site tries to increase their insurance coverage above a preset limit that transaction is denied. This illustrates that a restricted amount of coverage is available for that particular insurance policy and any amount beyond that limit will not be accepted. This restriction essentially withdraws the opportunity of increasing the amount coverage by the user, one of ordinary skill in the art at the time of the invention would have found it obvious to include the electronically withdrawing from availability any or said proposals whose acceptance would reduce said available risk assumptions capacity within the system as taught by Walker et al. with the motivation of preventing reinsurers from purchasing risk from a cedent that is not available via the Internet.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,093 to Walker et al. in view of "Can Life RE Pilots Online System for Direct Writers and Reinsures" by Bestwire (hereinafter "Bestwire"), for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

(A) Claim 4 has not been amended, and is rejected for the same reasons given in the previous Office Action (paper number 6), and incorporated herein. Further reasons appear hereinbelow.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Can Life RE Pilots Online System for Direct Writers and Reinsures" by Bestwire (hereinafter "Bestwire") and U.S. Patent No. 6,119,093 to Walker et al. in view of Official Notice, for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

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(A) Claim 11 has not been amended, and is rejected for the same reasons given in the previous Office Action (paper number 6), and incorporated herein. Further reasons appear hereinbelow.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,093 to Walker et al. and "Can Life RE Pilots Online System for Direct Writers and Reinsures" by Bestwire (hereinafter "Bestwire") in view of Official Notice, for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

(A) Claim 16 has not been amended, and is rejected for the same reasons given in the previous Office Action (paper number 6), and incorporated herein. Further reasons appear hereinbelow.

Response to Arguments

Applicant's arguments filed 1/14/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 1/14/03.

(A) In the remarks, Applicants argue in substance that, (1) Walker et al. fails to teach a risk carrier (such as a reinsurer) posting proposals to assume selected monetary risks (underwriting of an insurance contract) from a plurality of risk cedents (such as primary insurers); (2) Walker et al. fails to teach initializing on said server an available risk capacity or electronically recalculating said available risk assumption capacity; (3) Walker et al. fails to teach electronically withdrawing proposals from availability whose acceptance would reduce the available risk assumption capacity as recalculated, below a selected amount; (4) Bestwire reference dated November 12, 1999 is not prior art because it is less than one year prior to the

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filing date of the present application filed January 4, 2000; (5) Walker et al. does not discuss enabling the cedent to electronically decrease the amount of coverage of a proposal before posting it as an invitation to make an offer by a risk carrier; (6) Bestwire fails to teach evaluating an insurance portfolios and developing proposals to reinsure selected insurance portfolios applicable to treaty type insurance; and (7) Bestwire fails to teach or suggest available reinsurance capacity or anything comparable should be taken into consideration in determining which proposal should be made available or presented to the cedents.

(B) In response to Applicant's argument that, (1) Walker et al. fails to teach a risk carrier (such as a reinsurer) posting proposals to assume selected monetary risks (underwriting of an insurance contract) from a plurality of risk cedents (such as primary insurers). The Examiner respectfully submits that Walker et al. teaches insurance company server (100, Fig. 1) that transmits policy information relating to a policy or policies to a central server (120, Fig. 1) which makes the policy information available for viewing on a website (130, Fig. 1) to a user via the Internet (100, Fig. 1) through conventional user interface (140, Fig. 1). A user or investors (reads on "risk carrier") browses the various policies and picks one or more he is interested in and using conventional interface selects a policy by way of investment order (103, Fig. 1) and further makes an offer (reads on "posting") (see: column 4, lines 45-60 and Fig. 3c). The user or investor then directs his investment order to the insurance syndication service central server (120, Fig. 1) via the Internet (see: column 5, lines 3-8). The syndication central server transmits to the insurance company server updated syndication and transaction information (108, Fig. 1) (see: column 5, lines 44-47). This indicates that the user or investor (reads on "risk carrier" or

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“reinsurer”) investment order is posted to the insurance company’s (reads on “risk cedent”) (primary insurer) server via the Internet.

(C) In response to Applicant’s argument that, (2) Walker et al. fails to teach initializing on said server an available risk capacity or electronically recalculating said available risk assumption capacity. The Examiner respectfully submits Walker et al. teaches that an insurance syndication central server (120, Fig. 1) transmits to the insurance company server policy information used to calculate the amount of premium to be paid to by each investor (reinsurer) (see: column 5, lines 36-52 and Fig. 3c). In addition, the syndication central server transmits updated syndication and transaction information (108, Fig. 1) to the insurance company server (see: column 5, lines 44-47). This indicates that once the investor (“risk carrier” or “reinsurer”) makes payment, the amount of available risk assumption capacity is decreased (recalculated) and the policy information is updated.

(D) In response to Applicant’s argument that, (3) Walker et al. fails to teach electronically withdrawing proposals from availability whose acceptance would reduce the available risk assumption capacity as recalculated, below a selected amount. The Examiner respectfully submits that it was the Walker et al. reference, in light of the knowledge of well-known concepts of the prior art that was relied upon for the specific teaching of electronically withdrawing proposals from availability. Walker et al. in combination with what is well known in art, such as restricting user access to certain information once the user has selected a specific type of insurance in the previous Office Action clearly indicate that a user on an insurance web site selecting an icon for automobile insurance renders other types of insurance such as life or home insurance useless or unable to be accessed on that same web page. As a result this restricts

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the access to the other types of insurance such as life or home insurance essentially withdrawing them from availability to the user. As such, the knowledge and use of electronically withdrawing from availability of certain information, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patient does not specifically disclose a particular elements said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

(E) In response to Applicant's argument that, (4) Bestwire reference dated November 12, 1999 is not prior art because it is less than one year prior to the filing date of the present application filed January 4, 2000. The Examiner respectfully submits that the applied reference of Bestwire qualifies as prior art under 35 U.S.C. 103(a) and 35 U.S.C. 102(e) and might be overcome by an appropriate showing under 37 CFR 1.131. The Applicant fails to provide an Affidavit under 37 CFR 1.131 to properly antecede the Bestwire reference therefore the reference of Bestwire is applicable prior art.

(F) In response to Applicant's argument that, (5) Walker et al. does not discuss enabling the cedent to electronically decrease the amount of coverage of a proposal before posting it as an invitation to make an offer by a risk carrier. The Examiner respectfully submits Walker et al. teaches the insurance syndication central server (120, Fig. 1) that transmits to the insurance company server policy information such as investment orders used to calculate the amount of premium to be paid to by each investor (reinsurer) (see: column 5, lines 36-52 and Fig. 3c). In addition, the syndication central server transmits updated syndication and transaction information (108, Fig. 1) to the insurance company server (see: column 5, lines 44-47). This

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indicates that once the investor (“risk carrier” or “reinsurer”) makes payment, the amount of available risk assumption capacity available by the insurer/risk cedent is decreased (recalculated) and the policy information is updated. In addition, the syndication central server transmits to the insurance company server updated syndication and transaction information (108, Fig. 1) (see: column 5, lines 44-47). This further demonstrates that the user’s or investor’s (reads on “risk carrier” or “reinsurer”) investment order is posted to the insurance company’s (reads on “risk cedent”) (primary insurer) server via the Internet.

(G) In response to Applicant’s argument that, (6) Bestwire fails to teach evaluating an insurance portfolios and developing proposals to reinsure selected insurance portfolios applicable to treaty type insurance. The Examiner respectfully submits that the features upon which applicant relies (i.e., “.... insurance portfolios applicable to treaty type insurance”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(H) In response to Applicant’s argument that, (7) Bestwire fails to teach or suggest available reinsurance capacity or anything comparable should be taken into consideration in determining which proposal should be made available or presented to the cedents. The Examiner respectfully submits that the Walker et al. reference, and not Bestwire, *per se*, that was relied upon for the specific teaching of available reinsurance capacity. In addition, Walker teaches in one particular preferred embodiment, investors (reads on “risk carrier” or “reinsurer”) themselves arriving at a rate for a policy, by offering bids against a given portion of risk (see: column 14, lines 19-25) of the cedent. Bestwire was relied for primarily teaching of online

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system that enables life insurance direct writer (cedent or insurer) to shop for reinsurance through AgoraRe.com (see: paragraph 1 and 3). The reinsurer (risk carrier) examine each application and then return a response through the site where the cedent will review the responses and select the best offer or offers (see: paragraph 3) Thus, the proper combination of the applied references would be the incorporation of Bestwire's method of selling reinsurance within Walker's system and method of the sale of insurance.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

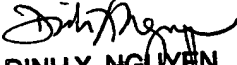
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM
rwm
March 6, 2003


DINH X. NGUYEN
PRIMARY EXAMINER